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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Richard E. Vogel

For: CONFECTION CUP ASSEMBLY

Serial No. 09/681,099

Group Art Unit: 3727

Docket No. 70254-328

BOARD OF APPEALS
Commissioner for Patents
Washington, D.C. 20231

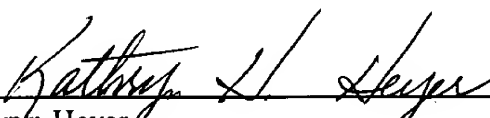
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Appeal Brief/Response
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard E. Vogel

For: CONFECTION CUP ASSEMBLY

Serial No.: 09/681,099


Examiner: Joseph C. Merek

Filed: January 4, 2001

Group Art Unit: 3727

Atty. Docket: 70254-328

Confirmation No.: 8152

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Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE

In response to the Notification of Non-Compliance mailed March 10, 2003, regarding the form of the Applicant's Appeal Brief filed December 3, 2002, attached is a new Appeal Brief, in triplicate.

It is respectfully submitted that the new Appeal Brief complies with all of the requirements of 37 CFR 1.192(c). For completeness, the action taken by Applicant to address each assertion of non-compliance is summarized below:

1. The appeal of the drawing rejection has been removed from the Appeal Brief as requested.
2. The 112 1st rejection of claim 59 is not addressed because claim 59 was canceled from the application in the Response filed October 3, 2002, for the purpose of having the remaining

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Examiner: Joseph C. Merek
Group Art Unit: 3727

amendments entered for appeal. Since claim 59 is no longer in the application, there is no need to address its rejection on appeal.

3. Claim 53 is not grouped because claim 53 was canceled from the application in the Response filed October 3, 2002, for the purpose of having the remaining amendments entered for appeal. Since claim 53 is no longer in the application, there is no need to assess its grouping.
4. The rejection of claim 53 over the Weymss patent is patent is not addressed for the reason that claim 53 is canceled from the application.
5. For what is now issue 5 since the drawing rejection is removed, claim 29 is now grouped with claim 26.
6. For what is now issue 5, claims 36 and 37 are no longer grouped together and now stand alone.
7. For what is now issue 6, claims 14-16 remain grouped together. Since claims 14-16 do rely on different arguments for patentability than claims 30 and 38, namely the limitations of claim 11 which are not found in claims 30 and 38, claims 30 and 38 have not been grouped with claims 14-16 as requested. However, claims 30 and 38 have been grouped together.
8. For what is now issue 8, claim 37 has been grouped with claim 34.

It is respectfully submitted that the new Appeal Brief conforms with the requirements of 37 CFR 1.192(c). If there are any questions, please contact the undersigned attorney.

Respectfully submitted,

Dated: 4/2/03

By: Mark A. Davis

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G0090272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Patent Application of

Richard E. VOGEL and
Timothy J. FOLTZ.

Serial No.: 09/681,099

Filed: January 4, 2001

For: CONFECTION CUP ASSEMBLY

Group Art Unit: 3727

Examiner: Merek, Joseph C.

APPEAL BRIEF

Assistant Commissioner of Patents
BOX AF
Washington, DC 20231

Sir:

This is an Appeal Brief under 37 C.F.R. §1.192 appealing the decision of the Examiner dated July 3, 2002. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

I. REAL PARTY IN INTEREST

Dart Container Corporation having offices in Mason, Michigan ("Dart") is the real party in interest of the present application. An assignment of all rights in the present application to Dart was executed by the inventors and recorded in the U.S. Patent and Trademark Office at reel 011476, frame 0909.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application of which the Appellants are aware.

III. STATUS OF CLAIMS

Claims 1-17, 19-30, 32, 34-38, 42, 43, 45, 46, 52, and 81, which are presented in the Appendix, are pending in the application and have been finally rejected by the Examiner. Claims 33, 39-41, 44, 47-51, and 53-61 have been canceled from the application without prejudice. Claims 18 and 31 are pending in the application and have been objected to by the Examiner. Claims 62-80 have been allowed and are not presented here on appeal. Accordingly, the Appellants hereby appeal the continuing rejection of claims 1-17, 19-30, 32, 34-38, 42, 43, 45, 46, 52, and 81.

IV. STATUS OF AMENDMENTS

Subsequent to the final Office Action dated July 3, 2002, a proposed amendment was filed on September 18, 2002, adding claim 81, canceling claims 53 and 54 without prejudice, amending claims 55 and 56 to change their dependency from claim 53 to claim 81, and adding new Figs. 13 and 14. The proposed amendment was not entered. A proposed amendment was filed on October 3, 2002, canceling claims 53-61 without prejudice solely to obtain entry of the amendment for purposes of appeal, again adding claim 81, and new Figs. 13 and 14. The October 3, 2002, proposed amendment was entered for purposes of appeal.

V. SUMMARY OF THE INVENTION

Appellants' invention relates to a confection cup assembly 10 for use in mixing the ingredients of a confection, such as a malt or the like, which can include chunks or particles of

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ingredients, like chocolate, mixed with the ice cream. The ingredients are placed in a cup and mixed using a mechanical stirrer.

The confection cup assembly comprises a collar 12 having a portion inserted within an open top of a conventional disposable confection cup 14, which is retained within a sleeve 16. The collar 12 and sleeve 16 cooperate to prevent the rotation of the confection cup 14 during the mixing of the confection ingredients. The sleeve 16 adds additional structural rigidity to the confection cup 14 to prevent damage of the cup during the mixing of the confection ingredients, especially from the pressure exerted on the cup walls from the dense and particle-laden confection slurry, and from the impact when the confection cup is struck against a work surface to encourage the confection ingredients to settle. (Application, ¶23.)¹

The collar 12 comprises an insert portion 20 and an extension portion 22 whose junction forms an annular shoulder 24. The insert portion 20 has an outer diameter sized so that it will be snugly received within the confection cup 14. (Application, ¶25.) The extension portion 22 extends above the confection cup 14 and terminates in an upper lip 26, which provides the open top of the extension 22 with additional hoop strength and a structure for mounting a lid (not shown), if desired. (Application, ¶26.)

The sleeve 16 comprises a body 40 defining a sleeve recess 45 terminating in an open top defined by an outwardly directed annular lip 42 on one end and a closed bottom formed by a bottom wall 44 on the opposing end. The cross-sectional profile of the body 40 preferably conforms to the cross-sectional profile of the cup 14, so that when the cup is completely received within the sleeve 16, the cup will be in abutting relationship with at least a portion, and preferably over the entire inner surface 41, of the body 40 of the sleeve 16. (Application, ¶29.)

The bottom wall 44 comprises an upper surface 49 that conforms to the base of the cup by providing an annular channel 50 defining and circumscribing a raised platform 52. The annular channel 50 and platform 52 conform to the shape of the confection cup bottom so that the external surface of the confection cup bottom is substantially completely supported by the

¹ The application giving rise to this appeal was filed using the Patent Office's electronic filing system without page and line numbering. Thus, supporting references are made to paragraph numbers rather than page and line numbers as otherwise required by 37 C.F.R. §1.192(c)(5).

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platform 52. (Application, ¶31.) The bottom wall 44 also includes an opening 54 extending entirely therethrough. The opening enables air to freely enter and exit the sleeve during the insertion and removal of the cup to relieve air pressure and ease the insertion and removal of the cup and ensure that the cup is properly seated against the bottom wall of the sleeve 16.

(Application, ¶33.)

The length of the sleeve 16 and the length of the insert portion 20 of the collar 12 are such that a portion of the confection cup 14 is frictionally and/or compressively retained therebetween. Preferably, the length of the sleeve 16 and the length of the collar insert portion 20 are such that the bottom 32 of the collar insert portion 20 extends below the lip 42 of the sleeve 16 to define a collar overlap area 34 and a sleeve overlap area 36 when the collar 12, confection cup 14, and sleeve 16 are assembled. Further, the inner diameter of the sleeve 16 and the outer diameter of the insert portion 20 along the overlap areas 34, 36 are such that they define a gap therebetween that is equal to or less than the thickness of the confection cup 14 along at least a portion of the overlap areas 34, 36 to ensure that at least a portion of the confection cup 14 is compressively retained between the sleeve 16 and the insert portion 20 of the collar 12.

(Application, ¶34.)

The sleeve can include at least one, but preferably multiple, longitudinal slots 62 extending substantially along the entire length of the body 40, dividing the body into multiple sections 64. The slots 62 permit the inner diameter of the sleeve to be adjusted by the user by merely squeezing the body 40 to press the various body sections 64 into contact with the confection cup 14 to add a compressive force directly to the exterior of the cup and improve any compressive or frictional retention between the overlapping portions of the sleeve and the collar 12 and between the sleeve and the cup alone. (Application, ¶38.) The collar 12 can be provided with a thin layer of frictional material 72, such as rubber, disposed about the periphery of the insert portion 20, preferably along the portion of the insert portion forming part of the overlap area 34, to improve the tendency of the confection cup 14 to remain stationary relative to the collar 12 and the sleeve 16 during the mixing of the confection ingredients (Application, ¶40).

The collar 12 can also be provided with a series of bumps, protrusions, or embossments 92 extending outwardly from the exterior surface of the insert portion 20. The bumps 92 abut

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and depress a portion of the inner surface of the confection cup 14 to retard the tendency of the confection cup 14 to spin relative to the collar 12. The bumps 92 can also be provided on the inner surface 41 of the sleeve 16. (Application, ¶42). Additionally, the sleeve can be provided with a series of ribs 82 extend inwardly along the inner surface 41 of the body 40. The ribs 82 preferably extend a sufficient distance from the inner surface 41 of the body 40 so that they will abut and depress a portion of the exterior surface of the confection cup 14 when the confection cup is inserted into the sleeve 16. Similar ribs can also be provided on the exterior surface of the insert portion 20 of the collar 12. (Application, ¶41).

VI. ISSUES

1. Whether the invention of claim 46 is properly rejected under 35 U.S.C. §112, first paragraph for the frictional material on the sleeve inner surface being made of a rubber material.

2. Whether the invention of claims 43 and 52 is anticipated under 35 U.S.C. §102(b) by Stokes et al. In the rejection of July 3, 2002, the Examiner rejected claims 43 and 52 as anticipated under 35 U.S.C. §102(b) by Stokes et al. Appellants disagree with the Examiner's assertion that claims 43 and 52 are anticipated under 35 U.S.C. §102(b) by Stokes et al.

3. Whether the invention of claims 42, 43, 45, and 52 is anticipated under 35 U.S.C. §102(b) by Fitzgerald et al. In the rejection of July 3, 2002, the Examiner rejected claims 42, 43, 45, and 52 as anticipated under 35 U.S.C. §102(b) by Fitzgerald et al. Appellants disagree with the Examiner's assertion that claims 42, 43, 45, and 52 are anticipated under 35 U.S.C. §102(b) by Fitzgerald et al.

4. Whether the invention of claim 46 is obvious under 35 U.S.C. §103(a) over Fitzgerald et al. in view of Staake. In the rejection of July 3, 2002, the Examiner rejected claim 46 as obvious under 35 U.S.C. § 103(a) over Fitzgerald et al. in view of Staake. Appellants disagree with the Examiner's assertion that the Fitzgerald et al. reference in view of the Staake reference renders the claimed invention obvious to one skilled in the art.

5. Whether the invention of claims 1-12, 19-29, 32, and 34-37 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341. In the rejection of

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July 3, 2002, the Examiner rejected claims 1-12, 19-29, 32, and 34-37 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 renders the claimed invention obvious to one skilled in the art.

6. Whether the invention of claims 14-16, 30, and 38 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and further in view of Smith et al. In the rejection of July 3, 2002, the Examiner rejected claims 14-16, 30, and 38 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and further in view of Smith et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 and the Smith et al. reference renders the claimed invention obvious to one skilled in the art.

7. Whether the invention of claims 17 and 30 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and Smith et al. and further in view of Fitzgerald et al. In the rejection of July 3, 2002, the Examiner rejected claims 17 and 30 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of French Patent FR 1,437,341 and Smith et al. and further in view of Fitzgerald et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of French Patent FR 1,437,341 and the Smith et al. reference, and further in view of the Fitzgerald et al. reference, renders the claimed invention obvious to one skilled in the art.

8. Whether the invention of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht (the Great Britain Patent). In the rejection of July 3, 2002, the Examiner rejected claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of Schmiedeknecht renders the claimed invention obvious to one skilled in the art.

9. Whether the invention of claims 14-16, 30, and 38 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht (the British Patent) and further in view of Smith et al. In the rejection of July 3, 2002, the Examiner rejected claims 14-16, 30, and 38 as

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obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and further in view of Smith et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of the Schmiedeknecht reference and further in view of the Smith et al. reference renders the claimed invention obvious to one skilled in the art.

10. Whether the invention of claims 17 and 30 is obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and Smith et al. and further in view of Fitzgerald et al. In the rejection of July 3, 2002, the Examiner rejected claims 17 and 30 as obvious under 35 U.S.C. §103(a) over Marsters et al. in view of Schmiedeknecht and Smith et al. and further in view of Fitzgerald et al. Appellants disagree with the Examiner's assertion that the Marsters et al. reference in view of the Schmiedeknecht reference and the Smith et al. reference, and further in view of the Fitzgerald et al. reference, renders the claimed invention obvious to one skilled in the art.

11. Whether the invention of claim 81 is obvious under 35 U.S.C. §103(a) over Wemyss in view of Good et al. In the rejection of July 3, 2002, the Examiner rejected claim 54 as obvious under 35 U.S.C. §103(a) over Wemyss in view of Good et al. In the Advisory Action dated October 18, 2002, the Examiner stated that claim 81 will be rejected in the same manner that claim 54 was rejected. Appellants disagree with the Examiner's assertion that the Wemyss reference in view of the Good et al. reference renders the claimed invention obvious to one skilled in the art.

VII. GROUPING OF CLAIMS

For the ground of rejection identified in Issue 2, claims 43 and 52 stand together as a group.

For the ground of rejection identified in Issue 3, claim 42, 43, 52 stand together as a group and claim 45 stands alone.

For the ground of rejection identified in Issue 5, claims 1-8 stand together as a group, claims 9-10 stand together as a group, claims 11-12 stand together as a group, claims 19-25 stand

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together as a group, claims 26-27 stand together as a group, claims 28-29 stand together as a group, claims 32, 36 and 37 stand alone, and claims 34-35 stand together as a group.

For the ground of rejection identified in Issue 6, claims 14-16 stand together as a group, and claims 30 and 38 stand together as a group.

For the ground of rejection identified in Issue 7, claims 17 and 30 stand together as a group.

For the ground of rejection identified in Issue 8, claims 1-7, 19-24, and 32 all stand together as a group, claims 9, 10, 26, 27, 34, 35, and 37 all stand together as a group, claims 11, 12, 28, 29, and 36 all stand together as a group, and claim 13 stands alone.

For the ground of rejection identified in Issue 9, claims 14-16, 30, and 38 all stand together as a group.

For the ground of rejection identified in Issue 10, claims 17 and 30 stand together as a group.

Arguments in support of the patentability of these claims are presented in the following remarks.

VIII. ARGUMENTS

1. WHETHER THE INVENTION OF CLAIM 46 IS PROPERLY REJECTED UNDER 35 U.S.C. §112, FIRST PARAGRAPH, FOR THE FRICTIONAL MATERIAL ON THE SLEEVE INNER SURFACE BEING MADE OF A RUBBER MATERIAL.

Claim 46 is rejected because "it has not been adequately disclosed that the sleeve has a rubber material on its inner surface." The basis for the rejection of claim 46 is that no drawing showed the rubber frictional material on the inner surface of the sleeve. With the acceptance of Fig. 14 in the Advisory Action of October 18, 2002, the specification now discloses the rubber frictional material on the sleeve inner surface as was described paragraph 40 of the original specification. Therefore, the rejection of claim 46 is no longer proper.

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2. WHETHER THE INVENTION OF CLAIMS 43 AND 52 IS ANTICIPATED UNDER 35 U.S.C. §102(b) BY STOKES ET AL.

Claims 43 and 52 stand rejected as being anticipated under 35 U.S.C. §102(b) by Stokes et al. For a reference to anticipate a claim under 35 U.S.C. §102(b), each and every element of the claim must be found in the reference. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed. Cir. 1998). Since claims 52 and 43 recite elements not found in Stokes et al., the anticipation rejection is not proper and cannot stand.

Independent claim 52 calls for a sleeve having, among other things, a friction enhancer on the sleeve comprising a frictional material that increases the frictional resistance between the sleeve and a cup received within the sleeve. Stokes et al. discloses a cup holder having a handle 25, a supporting platform 11, and two arms 16, 17 for partially encircling the container being held. The cup holder of Stokes et al. has no frictional material on the interior of the arms 16, 17 as called for by claim 52. Therefore, claim 52 is not anticipated by Stokes.

The Examiner asserts that the "piece of frictional material" limitation of claim 52 is satisfied by whatever frictional resistance is inherent in the surface of the material forming the Stokes et al. cup holder. Such an interpretation of the limitation "piece of frictional material" is improper because it ignores the plain meaning of what is meant by a piece of frictional material as disclosed in the specification and claims. Claim limitations are to be interpreted in light of the specification. Manual of Patent Examining Procedure, §2111.01 (citing *In re Marosi*, 710 F. 2d 799, 802 (Fed. Cir. 1983)). See, also, Manual of Patent Examining Procedure, §2106 (Examiner must rely on Applicant's disclosure to properly determine meaning of terms used in claims (citing *Markman v. Westview Instruments*, 52 F.3d 967, 980 (Fed. Cir. 1996))).

The application makes clear that the "piece of frictional material" is something other than the surface of the material forming the cup holder. The "piece of frictional material" is a separate and distinct element provided on the surface of the sleeve that increases the frictional resistance between the sleeve and the cup to a greater amount than what is provided by the surface of the sleeve alone. Stokes et al. discloses no such "piece of frictional material."

The term "friction enhancer" is used in the claims to generically reference any material or structure that improves or increases the friction between the sleeve/collar, as the case may be,

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and the cup as compared to the inherent frictional resistance of the sleeve/collar alone. Examples of the friction enhancers shown in the specification are the piece of rubber strip 72 (Figs. 10 and 14) and the ribs 82 or protruberances 92 (Figs. 11 and 12). The term "piece of frictional material" is used to identify a subset of frictional enhancers that are pieces of material placed on the surface of the sleeve/collar to enhance the frictional resistance between the sleeve/collar and the cup. One example of a frictional material is the piece of rubber 72. Stokes discloses no such frictional material and the anticipation rejection is not supportable.

Claim 43 depends from claim 52 and is not anticipated by Stokes for the same reasons as claim 52.

**3. WHETHER THE INVENTION OF CLAIMS 42, 43, 45, AND 52 IS ANTICIPATED
UNDER 35 U.S.C. §102(b) BY FITZGERALD ET AL.**

Claims 42, 43, 45, and 52 stand rejected as being anticipated by Fitzgerald et al. The anticipation rejection is improper since not every element of claim 52 is found in the Fitzgerald et al. reference.

Fitzgerald et al. discloses an insulated bottle holder 7 having four inwardly-extending, resilient longitudinal ribs 18. The bottle holder comprises a single sleeve portion that is molded from a plastic to form a rigid structure. A castellated opening 8 is formed in the bottom wall for receiving a traditional castle or crown-type bottle cap and functions as a bottle opener. Fitzgerald et al. fails to disclose the claimed piece of frictional material as called for by claim 52. Thus, claim 52 is not anticipated by Fitzgerald et al.

The Examiner asserts in the Office Action that the ribs 18 satisfy the "piece of frictional material" limitation of claim 52. Such is not the case. As stated above with respect to the Stokes et al. rejection, the "piece of frictional material" is a subset of the claimed friction enhancer. The "piece of frictional material" limitation covers a separate and distinct piece of material that is added to the sleeve surface to increase the friction between the sleeve and the cup to a greater amount than what would otherwise be developed between the surface of the sleeve and the cup without the frictional material. The "piece of frictional material" limitation does not cover structural appendages integrally formed with the sleeve, which is made clear in the claims. Thus,

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Fitzgerald et al. does not disclose a "piece of frictional material" as claimed in claim 52. Since claims 42, 43, and 45 depend from claim 52, they are not anticipated by Fitzgerald et al. for the same reasons as claim 52.

Claim 45 is independently not anticipated by Fitzgerald since the ribs 18 are not located adjacent an upper edge of the sleeve as called for by claim 45.

4. WHETHER THE INVENTION OF CLAIM 46 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER FITZGERALD ET AL. IN VIEW OF STAAKE.

Claim 46 in relevant part calls for a sleeve having a friction enhancer on the sleeve comprising a frictional material to increase the frictional resistance between the sleeve and an enclosed cup, wherein the frictional material is rubber.

Claim 46 stands rejected as being obvious over Fitzgerald et al. in view of Staake. The rejection is improper because the combination is not proper, and, assuming for the sake of argument the combination was proper, claim 46 is patentably distinct from the alleged combination.

A conclusion of obviousness must be based upon an Examiner's factual findings. "The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

To establish a *prima facie* case of obviousness, three basic criteria must be met:

- There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- There must be a reasonable expectation of success.
- The prior art reference must teach or suggest all the claimed limitations.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See also*, MPEP 706.02(j) and 2143-2143.03.

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of *whether there is teaching*,

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motivation, or suggestion to select and combine the references relied on as evidence of obviousness." See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham v. John Deere* factors) (*emphasis added*). Absent the Examiner identifying such motivation expressly contained in the references making up the combination, the Examiner's alleged combination is nothing but an exercise in impermissible prior-art-based hindsight reconstruction of the claimed invention. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the *subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*") (*Emphasis added.*) "The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. ... When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously." *Mcginley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001) (Citing *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher)).

As discussed above, Fitzgerald et al. discloses an insulated bottle holder having four inwardly-extending, resilient longitudinal ribs 18. The bottle holder comprises a single sleeve portion that is molded from a plastic to form a rigid structure. A castellated opening is formed in the bottom wall for receiving a traditional bottle cap and functions as a bottle opener. Staake discloses a rubber container for shipping an ice cream canister.

Initially, the rejection must fail because the combination is improper since Staake is non-analogous art. The test for determining whether a reference is analogous art has two criteria: "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is

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reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658-659 (Fed. Cir. 1992) (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)).

Staake is not within the field of endeavor for Appellants’ claimed sleeve. An ice cream package shipping container is not within the field of endeavor of a sleeve for supporting a confectionary cup. Nor is the invention of Staake reasonably pertinent to the same problem as Appellants’ invention. Staake is not related in any way to supporting a cup during the making of a confection. More specifically, Staake is not concerned with supporting the sidewall and/or bottom wall of a cup to protect the cup from the mixer and from pounding on the countertop to settle the contents of the confection. Staake is concerned with solving the problem of having a shipping container that can accommodate different sizes of ice cream packages or ice cream packages with varying or irregular shapes.

Assuming, however, for purposes of argument, that Staake can be considered analogous art, the rejection must fail in that the Examiner has made no showing of why a person of ordinary skill in the art would be motivated to combine the molded plastic bottle holder of Fitzgerald et al. with the rubber ice cream shipping container disclosed in Staake. In essence the combination would replace the molded plastic material of the Fitzgerald et al. bottle holder with rubber. The substitution of rubber for the plastic in Fitzgerald renders the entire cup holder deformable, which is a requirement of Staake. The deformable nature of the resulting cup holder is contrary to the teaching of Fitzgerald et al., which requires the bottom to be rigid so that it can receive a bottle cap in the castellated opening for removing crown-shaped bottle caps from bottles. The castellated opening is the key patentable feature of Fitzgerald et al., and making the bottle holder of Fitzgerald et al. from rubber like Staake destroys the functionality of Fitzgerald et al. Therefore, there is no teaching, motivation, or suggestion to make the combination as asserted.

Even if the combination of Fitzgerald et al. and Staake could be made, the resulting bottle holder made from rubber does not reach claim 46 which calls for a sleeve that has a piece of frictional material disposed on its inner surface. As previously discussed, the frictional material increases the friction between the sleeve and the cup as compared to the inherent friction developed by the inner surface of the sleeve alone. The Examiner’s asserted combination only

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results in the entire inner surface being made from a different material and not the addition of a piece of frictional material as required by claim 46. Nothing in the resulting combination results in an increase in the friction over the material forming the inner wall. Therefore, claim 46 is not obvious in view of the alleged combination.

5. WHETHER THE INVENTION OF CLAIMS 1-12, 19-29, 32, AND 34-37 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341.

The rejection of the claims over the combination of Marsters et al. and the French Patent is not supportable because the combination of Marsters et al. and the French Patent is not proper for multiple reasons.

Marsters et al. discloses a disposable insert 4 to be received within a supporting glass or cup 1 having a protecting portion 5, 6 which overlies the rim of the glass 1 to prevent a user's mouth from contacting the rim of the glass 1, thereby eliminating the need for cleaning of the glass 1 after each use.

The French Patent discloses a drinking container 1 comprising a cover 9 with a drinking spout 12 and an intervening baffle closure 5 having several apertures. The baffle closure 5 has a portion 6 that is inserted into the drinking container 1. The cover 9 has a portion 10 that is inserted into the top of the baffle closure 5. The apertures in the baffle closure 5 retard the flow of liquid from the drinking container and into the cover 9 to prevent liquid from rapidly flowing out of the drinking container 1 and through the spout 12 when the drinking container is tipped for drinking. The French Patent drinking container is akin to a child's sippy cup with a baffle for slowing the flow of liquid through the spout. Alternatively, the drinking container 1 can be used without the baffle closure 5 by installing the cover 9 directly onto the drinking container 1.

Initially, both Marsters et al. and the French Patent are non-analogous art. Marsters et al. is not within the field of endeavor of Applicants' invention. Marsters et al. is directed to a disposable insert which enables a glass to be repeatedly used by different users without the need to clean the glass after each use. Marsters et al. is totally unrelated to a confection cup assembly or to solving the problem of providing a supporting enclosure for a confection cup having a

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viscous liquid confection prepared therein..

The French Patent is also not within the field of Applicants' invention. The French Patent is directed to spill-proof or spill-resistant drinking containers and is not a confection cup assembly or any part of a confection cup assembly. The French Patent is not directed to solving the same problem as Appellants' invention, i.e. the retardation of the tendency of the cup to rotate in a sleeve when mixing a confection. The problem solved by the French Patent is that of spilling of the contents from a drinking container.

Second, assuming, *arguendo*, that the Marsters et al. Patent and the French Patent are analogous art, there is no teaching, motivation, or suggestion to combine the references as asserted by the Examiner. While Marsters et al. does disclose a cup support, the French Patent does not disclose any type of structure like the claimed collar as asserted by the Examiner. The French Patent only discloses a drinking container with a baffle and lid. The French Patent does not disclose a sleeve for supporting the cup 1 of the French patent. Nor is the baffle 5 of the French patent the claimed collar as asserted by the Examiner. Neither the baffle nor lid of the French patent serve to hold a cup in a sleeve (there is no sleeve in the French Patent), instead they serve to close the end of a cup. Therefore, there is no teaching or suggestion in either reference to make the combination as asserted by the Examiner.

Third, the Examiner's asserted teaching and suggestion for making the combination is not supported by either reference. The Examiner asserts, "FR '341, as seen in the Figs 1 and 2, teaches a collar for a cup. It would have been obvious to employ the collar of FR '341 in the cup of Marsters et al. so that the cup could be used by infants." This is pure conjecture and speculation and not supported expressly or inherently by either reference as required by law. The Examiner's failure to show support in either reference for the combination fails to establish a *prima facie* case of obviousness.

To make the combination, the Examiner had to improperly characterize the cup of the French Patent as the claimed sleeve. In doing so, the Examiner completely ignores the express structure of the French Patent, which shows a closed cup. The Examiner appears to have selected the Marsters et al. patent for its basic teaching of a disposable cup supported by a holder and then went looking for a reference that showed a collar received within the cup. The

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Examiner appears to have picked the French Patent because of the structural similarity of the baffle to the claimed collar. In doing so the Examiner ignores the clear showing in the drawings of the French Patent that there is no sleeve and he then asserts that it would be obvious to use the baffle for a collar, even though the baffle abuts the cup in the French patent. The Examiner's actions in forming the combination are a text book example of hindsight reconstruction, which is impermissible. Therefore, the combination is improper and the rejection of claims 1-12, 19-29, 32, and 34-37 is unsupportable.

Assuming, however, for purposes of argument, that the combination could be made, it would, at best, teach only a disposable insert and glass (Marsters et al.) closed by either a baffle closure with apertures or a cover and spout (French Patent). Either of these combinations necessarily closes the top of the Marsters et al. glass since both the baffle closure and the cover are closing elements and not a collar as claimed. In other words, the alleged combination only teaches adding a closing lid to the Marsters et al. insert and glass.

The combination does not reach the claims as asserted by the Examiner. Claim 1 calls for a confection cup assembly comprising a collar having an insert portion to be inserted into the open top of a cup, and a sleeve for receiving the cup, wherein a portion of the sleeve overlaps a portion of the collar insert portion to compress the cup between the sleeve and the insert portion. The claimed collar requires that a mixer or the like be received therethrough to permit the mixing of the ingredients. There would be no way in which to mix the confection ingredients through the closed top of the combination. Therefore, the alleged combination does not have the collar as claimed since the interior of the container cannot be accessed through the alleged combination and claim 1 is patentable over the alleged combination.

Claims 2-12 depend from claim 1 and are patentable over the claimed combination for the same reasons as stated for claim 1.

Claim 9 is independently patentable over the alleged combination. Claim 9 depends from claim 1 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotating, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the

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confection ingredients will not be mixed properly.

Claims 10-12 depend directly or indirectly from claim 9 and are patentable over the alleged combination for the same reasons as claim 9.

Claim 11 is independently patentable over the alleged combination by calling for the friction enhancer of claim 9 to be located on the overlap portion of the collar. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the overlap portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 12 depends from claim 11 and is patentable over the alleged combination for the same reasons as claim 11.

Independent claim 19 is independently patentable over the alleged combination. Claim 19 calls for a sleeve and collar as does claim 1. Claim 19 differs from claim 1 in that it defines the size of the sleeve relative to a cup and does not call for an overlapping portion between the collar and sleeve. Claim 19, like claim 1, is patentable over the alleged combination in that claim 19 calls for a collar and the combination does not disclose the claimed collar. The combination discloses a closed top regardless of how the references are combined. The collar by definition does not have a closed top and permits the insertion of a mixer into the sleeve to mix the ingredients of the confection.

Claims 20-29 depend from claim 19 and are patentable over the alleged combination for the same reasons as claim 19.

Claim 26 is independently patentable over the alleged combination. Claim 26 depends from claim 19 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotation, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the confection ingredients will not be mixed properly.

Claim 27 is patentable over the alleged combination for the same reasons as claim 26.

Claim 28 is independently patentable over the alleged combination by calling for the friction enhancer of claim 26 to be located on the overlap portion of the collar. Given that the

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overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 29 is patentable over the alleged combination for the same reason as claim 26.

Claim 32 is independently patentable over the combination. Claim 32 is similar in scope to claim 1, except that claim 32 additionally calls for the cup to be part of the cup assembly. However, like claim 1, claim 32 calls for a collar, which is not disclosed by the alleged combination.

Claims 34-37 depend directly or indirectly from claim 32 and are patentable over the alleged combination for the same reasons as claim 32.

Claim 34 is independently patentable over the alleged combination. Claim 34 depends from claim 32 and further calls for a friction enhancer provided on at least one of the collar and sleeve. The alleged combination does not disclose such a structure. The friction enhancer functions to improve the ability of the sleeve and collar to prevent the cup from rotation, which is easily caused by the mixer rotating the confection ingredients. If the cup rotates with the mixer, the confection ingredients will not be mixed properly.

Claim 35 is patentable over the alleged combination for the same reasons as claim 34.

Claim 36 is independently patentable over the alleged combination by calling for the friction enhancer of claim 34 to be located on the overlap portion of the collar. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claim 37 is patentable over the alleged combination for the same reason as claim 28.

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6. WHETHER THE INVENTION OF CLAIMS 14-16, 30, AND 38 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341 AND FURTHER IN VIEW OF SMITH ET AL.

The rejection of claims 14-16, 30 and 38 over the combination of Marsters et al, the French Patent, and Smith et al. is not proper because the combination is improper for multiple reasons.

Smith et al. discloses a funnel-like device having a neck 24 that is inserted into the neck of a bottle so that drinking from the bottle can be done in a manner similar to drinking from a glass. A seal or gasket 26 on the neck 24 seals the device into the bottle neck to eliminate leaking between the neck 24 and the bottle neck when a user drinks from the bottle.

First, the combination of Marsters et al, the French Patent, and Smith et al. is not proper in that it is based on adding Smith et al. to an already improper combination of Marsters et al. and the French Patent. The reasons for the impropriety of the combination of Marsters et al. and the French Patent are described above and apply equally as well here.

Second, the addition of Smith et al. to the combination of Marsters et al. and the French Patent cannot be sustained for reasons of its own. The Smith patent, like the Marsters et al. and the French Patent, is non-analogous art. Smith et al. discloses nothing more than a drinking aid to enlarge the drink opening of a bottle and is in no way within the field of Appellants' invention of a confection cup assembly. Nor is Smith et al. concerned with solving the problem of preventing a cup from rotating relative to a sleeve. Smith et al. addresses the problem of drinking from a bottle rather than from a glass.

Also, there is no teaching, motivation or suggestion to combine Smith et al. with the combination of Marsters et al. and the French Patent. The Examiner has cited to no teaching or suggestion in any of the three references that would support the combination. The Examiner's addition of Smith et al. to the combination appears to be based solely on the desire to find some type of friction enhancer rather than any teaching, motivation, or suggestion in the references themselves. Once again, the Examiner's asserted combination constitutes nothing more than classic impermissible hindsight reconstruction.

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Assuming, for purposes of argument, that the alleged combination could be made, it would only constitute the gasket or rib of Smith et al. circumscribing the baffle cover 5 or the cover 9 of the French Patent attached to a glass having a disposable insert as disclosed in Marsters et al. Such a combination does not reach the claimed invention of claims 14-16, 30, and 38 and the Examiner has failed to provide a *prima facie* case of obviousness as to these claims.

Claims 14-16 all depend indirectly from claim 1, and therefore require a collar. As previously stated, the Marsters et al. and French Patent combination did not disclose such a collar and the addition of Smith does not remedy the shortcomings of the prior combination. Therefore, claims 14-16 are patentable over the combination of Marsters, the French Patent, and Smith for the same reasons that claim 1 is patentable over Marsters and the French Patent.

Claim 14 is further patentable over the alleged combination in that claim 14 depends from claim 11 which calls for the friction enhancer of claim 9 to be located on the overlap portion of the collar, which is not disclosed by the alleged combination. Locating the friction enhancer in the overlap portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer. Since claims 15 and 16 depend from claim 14 they are also further patentable over the alleged combination.

Claim 30 depends from claim 19, and requires a collar as does claim 14. Since the alleged combination does not disclose the required collar, claim 30 is likewise patentable over the alleged combination.

Claim 38 depends from claim 32, and requires a collar as do claims 14 and 30. Since the alleged combination does not disclose the required collar, claim 38 is likewise patentable over the alleged combination.

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7. WHETHER THE INVENTION OF CLAIMS 17 AND 30 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF FRENCH PATENT FR 1,437,341 AND SMITH ET AL. AND FURTHER IN VIEW OF FITZGERALD ET AL.

The rejection of claims 17 and 30 over the combination of Marsters et al, the French Patent, and Smith et al. and further in view of Fitzgerald et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the four patents is not proper in that it is based on adding Fitzgerald to two already improper combinations of Marsters et al. and the French Patent, and the addition of Smith et al. The reasons for the impropriety of these two prior combinations are described above and apply equally as well here.

Second, the addition of Fitzgerald to the prior combination of Marsters et al. in view of the French Patent and Smith et al. cannot be sustained for reasons of its own. Fitzgerald et al., like the other three patents in the combination, is non-analogous art. Fitzgerald et al. discloses an insulated bottle holder having a bottle cap remover molded into the bottom wall, and is not within the same field of endeavor as Applicants' invention. Nor is Fitzgerald et al. directed to the same problem as the claimed invention. Fitzgerald et al. is directed to the problem of insulating a bottle and removing a bottle cap from the bottle. It is not directed to the problem of the rotation of a cup in a sleeve.

Third, there is no teaching, motivation or suggestion in any of the four references to combine Fitzgerald et al. with the prior combination. The Examiner has provided no express teaching or suggestion in any of the four references. The addition of Fitzgerald et al. appears to be based solely on the need to find some type of longitudinal rib to reach the elements of claims 17 and 30 rather than any teaching, motivation, or suggestion in the references themselves. The Examiner's asserted combination constitutes nothing more than impermissible hindsight reconstruction.

Assuming, for purposes of argument, that the alleged combination could be made, it would only constitute the rib of Fitzgerald et al. extending along the body of the Marsters et al. patent, whose open top is closed by the baffle cover 5 or the cover 9 of the French Patent. Such a combination does not reach the invention of claims 17 and 30, and the Examiner has

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failed to provide a *prima facie* case of obviousness as to these claims.

Claim 17 depends from claim 1, and therefore requires a collar. As previously stated, the Marsters et al., French Patent, and Smith et al. patent combination did not disclose such a collar and the addition of Fitzgerald does not remedy the shortcomings of the prior combination.

Claim 30 depends from claim 19, and requires a collar as does claim 17. Since the alleged combination does not disclose the required collar, claim 30 is likewise patentable over the alleged combination.

8. WHETHER THE INVENTION OF CLAIMS 1-7, 9-13, 19-24, 26-29, 32, AND 34-37 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDEKNECHT (THE BRITISH PATENT).

The rejection of claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37 over the combination of Marsters et al. and the British Patent is not proper because the combination is improper for multiple reasons.

The British Patent discloses a removable glass extension ring B for a drinking vessel A which keeps the consumer's mouth from contacting the drinking vessel A and which is removed for cleaning after the drinking vessel A has been used, thereby minimizing the unacceptable consequences of inadequately cleaned drinking vessels.

As previously stated, the Marsters et al. patent is non-analogous art. The British Patent, like Marsters et al., is also non-analogous art. The British Patent is not in the same field of endeavor as the Applicants' invention. A sanitary drinking ring is not the same field of endeavor as a sleeve and collar used to make a confection. The British Patent is not relevant to solving the problem of the invention. The British Patent solves the problem of how to make sure a glass is safe to drink from. It does not address the problem of how to prevent the rotation of a cup when making a confection. Since the patents of the combination are non-analogous art, the combination is improper and must fail. Without the combination, the rejection must also fail.

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Moreover, there is no teaching, motivation, or suggestion to make the combination as asserted. The Marsters et al. patent discloses a support and a removable cup insert. The British Patent discloses a cup with a sanitary ring. Neither of these two references discloses a structure capable of functioning as a confection cup assembly to prevent the rotation of a cup within a sleeve. Each of the patents is missing a crucial element of the invention. Marsters et al. is missing a collar. The British Patent is missing a sleeve and a collar.

In fact, the references teach away from such a combination. The support of Marsters et al. uses a disposable insert, and thus would have no need for the sanitary extension ring disclosed in the British Patent. Likewise, there is no need for the device of the British Patent to include a disposable insert as shown in Marsters et al. since it uses the sanitary ring.

The Examiner has offered no express teaching or suggestion in either of the references to make the alleged combination. The Examiner's reason for combining the references is based on his unsupported opinion that one would add the sanitary ring to Marsters et al. "to provide a hygienic drinking surface". Yet, there is no reason to add a sanitary ring to the Marsters et al. structure because the cup insert is disposable, and is expressly described so in the Marsters et al. patent. Once again, it appears that the only basis for the Examiner's attempt to combine the extension ring of the British Patent with Marsters et al. is that of hindsight reconstruction driven by the necessity of including a collar-like structure in order to reach the invention claimed in claims 1-7, 9-13, 19-24, 26-29, 32, and 34-37.

The combination of Marsters et al. and the British Patent to Schmiedeknecht is based solely on improper hindsight reconstruction. The Examiner has failed to provide a *prima facie* case of obviousness. Therefore, the rejection is improper and the rejection must fail.

Claims 9, 26, and 34 are independently patentable over the alleged combination. These claims all call for a friction enhancer on at least one of the collar or sleeve. The Examiner asserts that the friction enhancer limitation is met by the inherent frictional resistance in the material of the either the sleeve and collar. However, as previously described, the term friction enhancer as used in the application increases the frictional resistance of either the collar or sleeve beyond its inherent frictional resistance. The plain meaning of the term friction

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enhancer is consistent with the usage in the application. The friction enhancer enhances the friction of the collar or sleeve on which it is located.

Claims 10, 27, 35 and 37 all depend from one of claims 9, 26, and 34, and are patentable for the same reasons.

Claims 11, 28, and 36 all locate the friction enhancer on the overlap portion and are independently patentable over the alleged combination. Given that the overlap portion functions to compress the cup therebetween, locating the friction enhancer in the insert portion will further enhance the compression, which will also increase the static coefficient of friction to improve the performance of the friction enhancer.

Claims 12, 29 depend from claims 11, 28, respectively, and are patentable over the alleged combination for the same reasons.

Claim 13 calls for the friction enhancer to be rubber, and is thus independently patentable over the alleged combination. The use of rubber further enhances the friction of the collar or sleeve on which it is located beyond their inherent frictional resistance.

9. WHETHER THE INVENTION OF CLAIMS 14-16, 30, AND 38 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDEKNECHT (THE BRITISH PATENT) AND FURTHER IN VIEW OF SMITH ET AL.

The rejection of claims 14-16, 30, and 38 over the combination of Marsters et al, the British Patent, and Smith et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the three patents is not proper in that it is based on adding the Smith et al. patent to an already improper combination of Marsters et al. and the British Patent. The reasons for the impropriety of the prior combination are described above and apply equally as well here.

Second, the addition of Smith et al. to the prior combination of Marsters et al. in view of the British Patent cannot be sustained for reasons of its own. For the reasons previously stated all three patents are non-analogous art. The combination fails when any of the patents in the combination is non-analogous art.

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Third, there is no teaching, motivation or suggestion to combine Smith et al. with the combination of Marsters et al. and the British Patent. The Examiner has cited to no express teaching in any of the references to make the alleged combination. Smith et al. discloses a funnel with an O-ring seal. There is no teaching or suggestion in Smith et al. to combine it with either Marsters et al. or the British Patent to provide either the cup support or sanitary ring with an O-ring seal. Neither Marsters et al. nor the British Patent are concerned with forming a seal. The Examiner's stated reason for making the combination ("It would have been obvious to employ the rib of Smith et al in the modified container of Marsters et al to provide a liquid tight seal as taught by Smith et al.") is a manufactured reason for the sole purpose of having some basis for adding Smith et al. to the combination. The Examiner's addition of Smith et al. to the combination appears to be based solely on the desire to find some type of friction enhancer rather than any teaching, motivation, or suggestion in the references themselves. Once again, the Examiner's asserted combination constitutes nothing more than classic impermissible hindsight reconstruction. Therefore, the combination is not supportable by the prior art references and must fail, bringing down with it the rejection of claims 14-16, 30, and 38.

10. WHETHER THE INVENTION OF CLAIMS 17 AND 30 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER MARSTERS ET AL. IN VIEW OF SCHMIEDKNECHT AND SMITH ET AL. AND FURTHER IN VIEW OF FITZGERALD ET AL.

The rejection of claims 17 and 30 over the combination of Marsters et al, the British Patent, and Smith et al. and further in view of Fitzgerald et al. is not proper because the combination is improper for multiple reasons.

First, the combination of the four patents is not proper in that it is based on adding Fitzgerald to two already improper combinations of Marsters et al. and the British Patent, and the addition of Smith et al. The reasons for the impropriety of these two prior combinations are described above and apply equally as well here.

Second, the addition of Fitzgerald to the prior combination of Marsters et al. in view of the British Patent and Smith et al. cannot be sustained for reasons of its own. Fitzgerald et al.,

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like the other three patents in the combination, is non-analogous art for the reasons previously stated. Namely, Fitzgerald et al. discloses an insulated bottle holder having a bottle cap remover molded into the bottom wall, and is not within the same field of endeavor as Applicants' invention. Nor is Fitzgerald et al. directed to the same problem as the claimed invention. Fitzgerald et al. is directed to the problem of insulating a bottle and removing a bottle cap from the bottle. It is not directed to the problem of the rotation of a cup in a sleeve.

Third, there is no teaching, motivation or suggestion in any of the four references to combine Fitzgerald et al. to the prior combination. The Examiner has provided no express teaching or suggestion in any of the four references. The addition of Fitzgerald et al. appears to be based solely on the need to find some type of longitudinal rib to reach the elements of claims 17 and 30 rather than any teaching, motivation, or suggestion in the references themselves. The Examiner's asserted combination constitutes nothing more than impermissible hindsight reconstruction.

11. WHETHER THE INVENTION OF CLAIM 81 IS OBVIOUS UNDER 35 U.S.C. §103(a) OVER WEMYSS IN VIEW OF GOOD ET AL.

Claim 81 claims *inter alia* a sleeve for a confection cup assembly comprising a sleeve body having a bottom wall and a peripheral wall, at least one air passage through the bottom wall, and at least one longitudinal slot extending through the peripheral wall for deflecting the sleeve body inwardly to permit the application of a compressive force to the cup.

The Examiner stated in his October 18, 2002, Advisory Action that claim 81 would be rejected in the same manner that claim 54 was rejected in the previous Office action. Thus, the Examiner's arguments regarding claim 54 will be addressed with respect to claim 81.

The Examiner rejected claim 54 as being unpatentable over Wemyss in view of Good et al. This combination is untenable and cannot be sustained.

Wemyss discloses a magnetic coupler for holding various items from handheld electronic equipment to cups to the dash of a motor vehicle. In the cup holder embodiment shown in Figs. 4 and 5 of Wemyss, the upper portion of the sidewall is tapered and internal ribs 56 are provided. The taper in combination with the ribs has two functions. First, they permit the cup holder to

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accommodate various cup sizes. Second, they permit condensation release through the gaps formed between the cup and the sidewall since the ribs prohibit the cup from contacting the sidewall. (Col. 9, ln. 34-46). Figs. 19 and 20 of Wemyss disclose a variation to the cup holder that does not include flared sidewalls, but does have deep grooves 64 formed in the sidewall. In both embodiments, the bottom wall of the cup holder mounts one portion of the magnetic dash mount coupling.

Wemyss does not disclose the claimed opening in the bottom wall as called for by claim 81. Wemyss does not need such an opening because the ribs 56 keep the cup from contacting the wall, which will prevent the formation of a vacuum between the bottom of the cup and the cup holder upon removal. The location of a cup holder in the bottom wall of the Wemyss cup holder would also interfere with the magnetic coupling. Thus, Wemyss not only does not need such an opening in the bottom wall, Wemyss teaches away from such an opening in the bottom wall.

Good et al. is non-analogous art. Good et al. is not within the same field of endeavor as the claimed sleeve. Good discloses a protective end cap 10 for a scuba air tank 12 having a spoked configuration, thereby providing openings between the spokes 28. A protective end cap for a scuba air tank is not in the same field of endeavor as a sleeve for a cup. Further, Good et al. is directed to strengthening the bottom wall of an end cap by the use of spoke-like ribs against external impact. The claimed sleeve is directed to solving the problem of preventing the rotation of a cup mounted within the sleeve. Good et al. is not concerned with preventing the rotation of a cup placed within the sleeve. Since Good et al. is non-analogous art the combination fails, taking with it the basis for the rejection.

Not only has the Examiner not proffered sufficient evidence contained in the references to support the alleged combination, but has offered *no* evidence of teaching, suggestion or motivation to combine the Wemyss and Good et al. references. Rather, the Examiner leaps directly into the factual disclosures of each reference in the alleged combination without setting forth the reasons for combining them.

There is nothing in either patent to suggest their combination. In fact, the Wemyss patent teaches away from making such a combination because a magnetic coupling device is mounted to its bottom wall and the ribs keep the cup spaced from the cup holder sidewall, which

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eliminates the formation of a vacuum, negating the need for an opening in the bottom wall. The Good et al. patent is not concerned with the formation of a vacuum in the bottom wall. The openings in the Good et al. device exist to permit the drainage of water downward through the openings. Thus, there is no teaching or suggestion to make the combination.

Assuming for sake of argument that the combination could be made, the resulting device would comprise a cup holder having a spoked bottom and a magnetic coupler for holding the cup holder to the dash of a motor vehicle. The combination does not reach the sleeve called for in claim 81. The combination does not disclose a sleeve with a longitudinal slot that permits the deflection of the side wall in combination with an opening in the bottom wall to prevent the formation of a vacuum.

CONCLUSION

In view of the foregoing, it is submitted that the continuing rejection of claims 1-17, 19-30, 32, 34-38, 42, 43, 45, 46, 52, and 81 is improper and should not be sustained. Therefore, a reversal of the rejection of July 3, 2002, is respectfully requested.

Respectfully submitted,

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IX. APPENDIX

1. A confection cup assembly for mixing the ingredients of a confection in a cup, the cup comprising a cup body having an open top, the cup body defining a cup recess, the open top providing access to the cup recess, and a bottom wall opposite the open top closing an end of the cup body, the confection cup assembly comprising:

5 a collar having an insert portion sized to be slidably received within the cup open top and into the cup recess; and

a sleeve comprising a sleeve body having an open top, the sleeve body defining a sleeve recess and the sleeve open top providing access to the sleeve recess, the sleeve being sized to slidably receive the cup;

10 a portion of the sleeve overlapping a portion of the collar insert portion when the cup is inserted into the sleeve and the collar is inserted into the cup to compress the cup therebetween and frictionally retain the cup therebetween.

2. The confection cup assembly according to claim 1, wherein the cup exterior profile and the sleeve recess interior profile are complementary at least along a portion of the cup extending into the sleeve recess.

3. The confection cup assembly according to claim 1, wherein the sleeve further comprises a bottom wall closing the sleeve opposite the open top.

4. The confection cup assembly according to claim 3, wherein the bottom wall comprises at least one air passage extending therethrough.

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5. The confection cup assembly according to claim 4, wherein the sleeve upper surface and the cup lower surface are in abutting relationship.
6. The confection cup assembly according to claim 1, wherein the sleeve body tapers in a direction away from the open top.
7. The confection cup assembly according to claim 1, wherein the collar further comprises an extension portion extending above the open top of the cup.
8. The confection cup assembly according to claim 7, wherein the junction of the extension portion and the insert portion forms a shoulder that abuts the open top to limit the insertion of the collar into the cup.
9. The confection cup assembly according to claim 1, and further comprising a friction enhancer provided on at least one of the collar and sleeve.
10. The confection cup assembly according to claim 9, wherein the friction enhancer is provided on the insert portion of the collar.
11. The confection cup assembly according to claim 9, wherein the friction enhancer is provided on the overlap portion of at least one of the collar and the sleeve.
12. The confection cup assembly according to claim 11, wherein the friction enhancer comprises a frictional material.
13. The confection cup assembly according to claim 12, wherein the frictional

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material is rubber.

14. The confection cup assembly according to claim 11, wherein the friction enhancer comprises at least one protrusion extending outwardly from an exterior surface of the insert portion.

15. The confection cup assembly according to claim 14, wherein the protrusion is an annular rib.

16. The confection cup assembly according to claim 14, wherein the protrusion is an embossment.

17. The confection cup assembly according to claim 9, wherein the friction enhancer is a longitudinal rib extending away from an interior surface of the sleeve.

19. A confection cup assembly for mixing the ingredients for a confection in a cup, the cup comprising a cup body having an open top, the cup body defining a cup recess, the cup open top providing access to the cup recess, and a bottom wall closing the cup opposite the cup open top, the confection cup assembly comprising:

5 a collar having an insert portion sized to be slidably received within the cup open top and into the cup recess; and

a sleeve comprising a sleeve body, an open top, and a bottom wall closing the sleeve opposite the open top, the sleeve body defining a sleeve recess, the sleeve open top providing access to the sleeve recess, the sleeve being sized to slidably receive the cup such that
10 at least a portion of the sleeve bottom wall is in abutting relationship with at least a portion of the

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cup bottom wall.

20. The confection cup assembly according to claim 19, wherein a portion of the sleeve body overlaps a portion of the collar insert portion to compress the cup therebetween and frictionally retain a portion of the cup along the overlap portion.

21. The confection cup assembly according to claim 19, wherein the cup exterior surface and the sleeve recess interior surface are in abutting relationship along at least a portion of the cup extending into the sleeve recess.

22. The confection cup assembly according to claim 19, wherein the bottom wall comprises at least one air passage extending therethrough.

23. The confection cup assembly according to claim 19, wherein the sleeve body tapers in a direction away from the open top.

24. The confection cup assembly according to claim 19, wherein the collar further comprises an extension portion extending above the open top of the cup.

25. The confection cup assembly according to claim 24, wherein the junction of the extension portion and the insert portion forms a shoulder adapted to abut the cup open top to limit the insertion of the collar into the cup.

26. The confection cup assembly according to claim 19, further comprising a friction enhancer provided on at least one of the collar and sleeve.

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27. The confection cup assembly according to claim 26, wherein the friction enhancer is provided on the insert portion of the collar.

28. The confection cup assembly according to claim 26, wherein the friction enhancer is provided on the overlap portion of at least one of the collar and the sleeve.

29. The confection cup assembly according to claim 26, wherein the friction enhancer comprises a frictional material.

30. The confection cup assembly according to claim 26, wherein the friction enhancer comprises at least one protrusion extending outwardly from an exterior surface of the insert portion or an interior surface of the sleeve.

32. A confection cup assembly for mixing the ingredients for a confection, the confection cup assembly comprising:

a cup comprising a cup body having an open top, the cup body defining a cup recess, the cup open top providing access to the cup recess, and a bottom wall closing the cup opposite the
5 cup open top;

a collar having an insert portion sized to be slidably received within the cup open top and into the cup recess; and

a sleeve comprising a sleeve body having an open top, the sleeve body defining a sleeve recess and the sleeve open top providing access to the sleeve recess, the sleeve being sized
10 to slidably receive the cup;

a portion of the sleeve overlapping a portion of the collar insert portion when the

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cup is inserted into the sleeve and the collar is inserted into the cup to compress the cup therebetween and frictionally the cup therebetween.

34. The confection cup assembly according to claim 32, and further comprising a friction enhancer provided on at least one of the collar and sleeve.

35. The confection cup assembly according to claim 34, wherein the friction enhancer is provided on the insert portion of the collar.

36. The confection cup assembly according to claim 34, wherein the friction enhancer is provided on the overlap portion of at least one of the collar and the sleeve.

37. The confection cup assembly according to claim 34, wherein the friction enhancer comprises a frictional material.

38. The confection cup assembly according to claim 34, wherein the friction enhancer comprises at least one protrusion extending outwardly from an exterior surface of the insert portion or an interior surface of the sleeve.

42. The sleeve according to claim 52, wherein the bottom wall of the sleeve comprises at least one air passage extending therethrough.

43. The sleeve according to claim 52, wherein the sleeve body tapers in a direction away from the open top.

45. The sleeve according to claim 52, wherein the friction enhancer is provided on the

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sleeve adjacent the upper edge.

46. The sleeve according to claim 52, wherein the frictional material is rubber.

52. A sleeve for a confection cup assembly for mixing the ingredients for a confection comprising a cup and a collar, the cup having a cup body defining a cup recess with an open top and a closed bottom, and the collar having an insert portion sized to be slidably received within the cup open top and into the cup recess, the sleeve comprising:

5 a sleeve body defining a sleeve recess for receiving the cup, the sleeve body having a bottom wall for supporting the bottom wall of the cup and a peripheral wall extending away from the bottom wall and terminating in an upper edge to define an open top providing access to the sleeve recess, and

a friction enhancer comprising a piece of frictional material provided on the sleeve for
10 increasing the resistance between the sleeve and the cup when a sleeve is received in the cup.

81. A sleeve for a confection cup assembly for mixing the ingredients for a confection, the cup assembly comprising a cup and a collar, the cup having a cup body defining a cup recess with an open top and a closed bottom, and the collar having an insert portion sized to be slidably received within the cup open top and into the cup recess, the sleeve comprising:

5 a sleeve body defining a sleeve recess for receiving the cup, the sleeve body having a bottom wall for supporting the bottom wall of the cup and a peripheral wall extending from the bottom wall and terminating in an upper edge to define an open top providing access to the sleeve recess, at least one air passage extending through the bottom wall, and at least one longitudinal slot extending through the peripheral wall to permit the sleeve body to be deflected

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- 10 into the sleeve recess and thereby permit the application of a compressive force to the cup when the cup is received within the sleeve recess to frictionally restrain the cup from movement relative to the sleeve body.